

ESTTA Tracking number: **ESTTA496800**

Filing date: **09/26/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Rocket Pictures Limited
Granted to Date of previous extension	09/26/2012
Address	1 Blythe Road London, W14 0HG UNITED KINGDOM
Attorney information	Howard J. Shire, Esq. Kenyon and Kenyon LLP One Broadway New York, NY 10004 UNITED STATES tmdocketny@kenyon.com Phone:212-425-7200

Applicant Information

Application No	85374926	Publication date	05/29/2012
Opposition Filing Date	09/26/2012	Opposition Period Ends	09/26/2012
Applicant	Disney Enterprises, Inc. 500 South Buena Vista Street Burbank, CA 91521 UNITED STATES		

Goods/Services Affected by Opposition

Class 009.

All goods and services in the class are opposed, namely: Apparatus for recording, transmission or reproduction of sound or images; pre-recorded optical and magneto-optical discs, CDs and DVDs featuring music, stories, dramatic performances, non-dramatic performances, learning activities for children and adults, and games; audio books featuring fiction; audio recordings featuring music, stories, dramatic performances, non-dramatic performances, learning activities for children, and games; downloadable ringtones and sound recordings featuring music and other sounds, all for wireless communications devices; audio and visual recordings featuring live-action entertainment, animated entertainment, music, stories, and games for children; musical recordings; video game software; computer game software; computer software featuring learning activities for children; chips containing musical recordings; computer hardware and peripheral devices; mouse pads; wrist and arm rests for use with computers; calculators; electrical and optical cables; electronic personal organizers; personal digital assistants; camcorders; cameras; digital cameras; optical and magneto-optical disc players and recorders for audio, video and computer data; radios; television sets; video game machines for use with televisions; audio speakers; headphones; earphones; walkie-talkies; pagers; telephones; videophones; head sets for cellular telephones; adapters for cellular telephones; batteries for cellular telephones; cellular telephone cases; face plates for cellular telephones; eyeglasses; sunglasses; eyeglass and sunglass cases; decorative magnets; graduated rulers;

electronic games and game software that may be downloaded via global computer networks and electronic communication networks for use in connection with computers, mobile computers, media players, cellular phones, wireless devices and portable and handheld digital electronic devices
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	including without limitation, the marks GNOME & JULIET and SHERLOCK GNOMES		
Goods/Services	International Class 9		

Attachments	GNOME TOWN - opposition.pdf (6 pages)(226815 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MICHELLE M. MARSH/
Name	MICHELLE MANCINO MARSH, ESQ.
Date	09/26/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of : Disney Enterprises, Inc.
Serial No. : 85/374,926
Filed : July 19, 2011
For : "GNOME TOWN"

ROCKET PICTURES LIMITED,

Opposer,

-against-

DISNEY ENTERPRISES, INC.,

Applicant.

Opposition No.: _____

Mark: GNOME TOWN

Serial No.: 85/374,926

NOTICE OF OPPOSITION

Rocket Pictures Limited ("Opposer"), a corporation organized and existing under the laws of the United Kingdom with an address at 1 Blythe Road, London, United Kingdom, W14 0HG, by its undersigned counsel, hereby submits the following Notice of Opposition. Opposer believes that it will be damaged by the registration of the above-identified mark, and hereby opposes registration thereof. The grounds for opposition are as follows:

1. By the application herein opposed, Serial No. 85/374,926, Disney Enterprises, Inc. (or "Applicant") is seeking to obtain, under the provisions of the Trademark Act (15 U.S.C. § 1051), registration of the mark GNOME TOWN in International Class 9 for "Apparatus for recording, transmission or reproduction of sound or images; pre-recorded optical and magneto-

optical discs, CDs and DVDs featuring music, stories, dramatic performances, non-dramatic performances, learning activities for children and adults, and games; audio books featuring fiction; audio recordings featuring music, stories, dramatic performances, non-dramatic performances, learning activities for children, and games; downloadable ringtones and sound recordings featuring music and other sounds, all for wireless communications devices; audio and visual recordings featuring live-action entertainment, animated entertainment, music, stories, and games for children; musical recordings; video game software; computer game software; computer software featuring learning activities for children; chips containing musical recordings; computer hardware and peripheral devices; mouse pads; wrist and arm rests for use with computers; calculators; electrical and optical cables; electronic personal organizers; personal digital assistants; camcorders; cameras; digital cameras; optical and magneto-optical disc players and recorders for audio, video and computer data; radios; television sets; video game machines for use with televisions; audio speakers; headphones; earphones; walkie-talkies; pagers; telephones; videophones; head sets for cellular telephones; adapters for cellular telephones; batteries for cellular telephones; cellular telephone cases; face plates for cellular telephones; eyeglasses; sunglasses; eyeglass and sunglass cases; decorative magnets; graduated rulers; electronic games and game software that may be downloaded via global computer networks and electronic communication networks for use in connection with computers, mobile computers, media players, cellular phones, wireless devices and portable and handheld digital electronic devices” (the “Application”). Applicant filed its Application on an intent-to-use basis pursuant to Section 1(b) of the Trademark Act. The Application was published for opposition on May 29, 2012.

2. Opposer produced the major motion picture entitled GNOMEO & JULIET released in theaters in or about February 2011 and on DVD in March 2011.

3. Opposer is the owner of a family of trademarks which incorporate the term GNOME, including, without limitation, the marks GNOMEO & JULIET and SHERLOCK GNOMES (collectively, Opposer's "GNOME Marks"), for use in connection with a variety of goods, including, among other things, visual recordings featuring animated entertainment, music, and stories, and DVDs featuring music, stories and dramatic performances. Opposer's rights in the GNOME Marks date back to at least as early as February 2011.

4. Opposer, by virtue of its prior use of its GNOME Marks, as well as extensive advertising and promotional efforts connected therewith, has acquired valuable goodwill in the GNOME Marks. Opposer's GNOME Marks are not only distinctive, but have acquired secondary meaning in the minds of consumers in connection with Opposer.

5. Opposer has superior rights in and to its GNOME Marks because its use of the mark in United States commerce predates Applicant's use and the filing date of the Application, as well as any potential entry into said market by Applicant.

6. Applicant's GNOME TOWN mark is confusingly similar to Opposer's GNOME Marks, and will be used on and in connection with the same class of goods. Applicant's GNOME TOWN mark is likely to cause confusion with Opposer's GNOME Marks among the trade and relevant purchasing public.

7. Any such confusion in trade and among the public inevitably would result in loss of sales, damage, and injury to Opposer.

8. Moreover, use of Applicant's Mark in conjunction with the applied-for goods would dilute the distinctive quality of Opposer's GNOME Marks, thereby causing damage to Opposer.

9. By reason of the foregoing, Opposer respectfully submits that Applicant's registration of the mark opposed herein opposed would cause significant damage and injury to Opposer, to Opposer's rights in its GNOME Marks, and to the use thereof as described herein. Thus, Applicant's mark should be denied registration under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)).

10. The statutory fee, and any additional required fees associated with this proceeding, that are not paid during the course of the electronic filing process should be charged to the undersigned's Deposit Account No. 11-0600.

WHEREFORE, Opposer prays that Application Serial No. 85/374,926 be rejected, and that registration of the mark therein sought for the goods therein specified be denied and refused, and that this Opposition be sustained.

Respectfully submitted,

Dated: September 26, 2012

KENYON & KENYON LLP

Attorneys for Opposer
Rocket Pictures Limited

A handwritten signature in black ink, appearing to read 'Howard J. Shire', written over a horizontal line.

Howard J. Shire
Michelle Mancino Marsh
Natasha Sardesai-Grant
One Broadway
New York, New York 10004
Tel: 212-425-7200
Fax: 212-425-5288

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Rocket Pictures Limited's NOTICE OF OPPOSITION was served by first class mail to Applicant's counsel of record on the 26th day of September, 2012, at the following address:

Brian Rupp, Esq.
The Walt Disney Company
500 S Buena Vista St
Burbank, CA 91521-0007



Natasha Sardesai-Grant